

remarks, as well as those accompanying the second Preliminary Amendment of December 1, 1989, before setting up any interference.

By way of background, it is useful to recall the following: After an interview on January 6, 1989 in Chu's earlier Application Serial No. 12,205, this File Wrapper Continuing Application (FWC) was filed January 23, 1989 with a Preliminary Amendment submitting claims 17-21 in lieu of the earlier claims. The remarks of that Preliminary Amendment stated that it was

"... Applicant's singular desire to reach a holding of allowable subject matter as quickly as possible It is believed that allowable subject matter is presented by all of claim 17-21 and a prompt indication of allowability is respectfully requested."

(p. 11-12 of Amendment)

This FWC Application with its Preliminary Amendment was hand-delivered to the Commissioner's office and, as Applicant's attorney understands, it was specially processed for a serial number assignment and delivered to the Examiner shortly thereafter. In early February 1989, a telephone communication confirmed that the Examiner was aware of the serial number and status of this File Wrapper Continuing Application.

In March 1989, the Examiner by a telephone call advised that an interference involving this application would soon be declared -- by the end or soon after the end of the first quarter examining period of 1989. However, there was no further communication from the Examiner relative to this FWC Application until early November when the Examiner called the undersigned's office to discuss

the application. During this call on November 6, 1989, the Examiner indicated that he had formulated a count for an interference and suggested that a claim worded similar to the proposed count be added to this Chu application by telefaxing to the Patent Office a Preliminary Amendment including such a claim. The Examiner was advised that the informal suggestion to add such a claim would be discussed among counsel and we would get back to him as soon as possible.

On November 21, 1989, the Examiner called to inquire about the status of the requested amendment adding such claim. Counsel advised the Examiner that a substantial preliminary amendment was then being prepared which would add claims substantially of the scope the Examiner wanted but that such claim would be dependent from a more generic claim which Applicant believed to be patentable. During this call, the Examiner was advised of the language of the genus and dependent claims being contemplated.

On Thursday, November 30, 1989, the Examiner again called about the status of the Preliminary Amendment and was advised it would be ready for mailing that day. The Examiner requested that it be hand-delivered to the receptionist in Art Unit 110 on the 9th Floor in Crystal Plaza Building No. 3. In compliance with the Examiner's request, this Preliminary Amendment (second), which added claims and discussed the allowance of the claims over all known prior art, was hand-delivered on Friday, December 1, 1989. An attempt was made to inform the Examiner of its delivery but he was out of the office that day.

On Monday, December 4, 1989, the Examiner again called asking if the Preliminary Amendment had been filed and was informed it had been.

On Tuesday, December 5, 1989, the Examiner again called to inform the undersigned that he had located the Preliminary Amendment which was filed December 1. The Examiner again stated that he wanted Applicant to add an independent claim worded in a manner similar to the proposed count and specifically requested that Applicant Fax a Preliminary Amendment adding such an independent claim. The Examiner related that he did not want to delay matters by sending an action letter demanding that Applicant copy such an independent claim and, if such a claim was not voluntarily added by a Preliminary Amendment promptly, then he would set up an interference on the count as he originally proposed and would correspond pending claim 18 of this FWC Application to the interference count.

In view of such remarks, the Examiner was asked why he was so adamant about declaring an interference on the narrow, species count he had proposed rather than on a broader genus count similar to claim 22 which Applicant had submitted by Preliminary Amendment (second) of December 1. In response, the Examiner related that: (1) he was "uncertain of the patentability" of the broader claim, (i.e. claims 22-23); (2) he was certain of the patentability of a claim like the species count he proposed; (3) he understood Applicant's position as set forth in the Remarks of the Preliminary Amendment filed December 1, 1989 urging a broader count for interference;

(4) whether applicant was entitled to allowance of broader claims (like claims 22-23) could be resolved during ex parte prosecution following the conclusion of an interference on his species count; and (5) that a priority issue existed relative to the species count he proposed and the priority issue should be resolved before addressing the "technical" patentability of Applicant's broader claims.

Again on Wednesday, December 6 and Thursday, December 7, 1989, the Examiner called to inquire whether a Preliminary Amendment adding a claim in independent form as he suggested would be filed.

While the Examiner's recent interest in pushing the prosecution of an interference forward is desirable, it appears to Applicant that the Examiner does not want to address the patentability of genus claims such as claims 19, 22 and 23, even though Applicant filed an extended amendment on December 1 discussing all relevant prior art known to his counsel in order to demonstrate the clear allowability of the broad claims herein. Applicant believes this piecemeal approach to acting on the merits of this application is grossly inefficient and contrary to sound interference practice.

Applicant is aware of the fact from third party sources that as early as March 1989 the Examiner had reached a decision that a claim substantially similar to Applicant's claim 18 was allowable to another applicant but for the issue of priority. Moreover, during the November 6, 1989 telephone call, the Examiner informed Applicant that an interference was to be set up with a

claim like claim 18, but which did not contain some of its limitations which were not necessary to patentability.

Although some eight months have elapsed since the Examiner found allowable subject matter in the application of another deemed by him to interfere with claims pending in this FWC application, the Examiner has yet to act on the merits of any claim pending in this Chu application. Instead of acting on the merits of claims 17-26 now pending herein, the Examiner has instructed Applicant to add a claim of another party so he can declare an interference which, by operation of 37 C.F.R. § 1.615, will suspend ex parte prosecution on the other claims pending in this application. With such suspension, the Examiner avoids having to reach any decision on the patentability of claims in this Application which are broader than the species claim proposed as an interference count even though they are ripe for action on the merits.

The effect of a declaration of interference and suspension of ex parte prosecution herein will cause two species interferences to proceed (each directed to particular species of a Y-Ba-Cu-O superconductive composition, one being $Y_1Ba_2Cu_3O_z$ in Interference No. 101,981, and the second being a newly declared interference on $Y_{1.2}Ba_{0.8}Cu_1O_y$) while the patentability of the broad Y-Ba-Cu-O superconductive composition genus remains unaddressed.

It is Applicant's belief that, chronologically, Chu's conception and constructive reduction to practice of the Y-Ba-Cu-O superconductive genus occurred first, an actual reduction to practice of a species within such genus

occurred second with the $Y_{1.2}Ba_{0.8}Cu_1O_y$ species, and that the "identification invention" of the $Y_1Ba_2Cu_3O_z$ species occurred third. Applicant believes it to be both improper and inefficient to avoid addressing the patentability of the first-in-time Y-Ba-Cu-O superconductive genus while addressing the patentability of second-and-third-in-time species of such a genus. More than one interference may be necessary, but surely one of them should be broad enough to allow the Board to determine priority with respect to the superconductive Y-Ba-Cu-O compositions. To set up narrow interferences on species is both inefficient and counterproductive. See the discussion in Heymes v. Takaya, 6 U.S.P.Q.2d 1448 (Bd. Pat. Int. 1988) to which reference was made in Applicant's Preliminary Amendment (second).

First, it produces piecemeal examination of the claims of this Application contrary to the provisions of M.P.E.P. § 707.07(g); and second, it potentially places the patentability of the first-in-time Y-Ba-Cu-O genus in jeopardy in the event of an adverse award of priority relative to the second-in-time $Y_{1.2}Ba_{0.8}Cu_1O_y$ species or the third-in-time $Y_1Ba_2Cu_3O_z$ species. This is especially harmful since the Examiner has so far avoided having to reach a determination on the record that such species are "separate patentable inventions" with respect to their genus.

Applicant has treated the Examiner's telephone suggestions to add a claim in independent form worded in like manner to the count proposed by the Examiner to be a demand under 37 C.F.R. § 1.605 to copy such claim or, by

refusing to copy, to disclaim the invention defined by the suggested claim. Accordingly, by this Third Preliminary Amendment, Applicant is adding as an independent claim, a claim exactly as suggested by the Examiner, albeit one the substance of which already pends in this Application as claims 18 and 24 which define the same general patentable subject matter.¹

Applicant is entitled to a full action on the merits of all claims now pending in this application (i.e., claims 17-21 pending since January 23, 1989; claims 22-26 pending since December 1, 1989; and claim 27 pending on receipt of this amendment).

If there is some compelling reason why the Examiner wants to declare an interference right this minute instead of first acting on this application and waiting to see the format of Interference 101,981 after the preliminary motions are decided, it is not apparent on the face of things. Indeed, since the interference which the Examiner now so urgently proposes to declare could have been declared some eight months ago, Applicant cannot understand the reason for the Examiner's sudden found

1 As noted, the claim suggested by the Examiner was exactly copied as suggested, even though the subscript convention of the nominal formula is different from Applicant's subscript convention. The correspondence between the Examiner's subscript convention to that of Applicant's is as follows: "a" = a-ax; "b" = x; "c" = b; and "x" = y; wherein in Applicant's subscript convention Applicant's "a" is 2 and Applicant's "x" is 0.4 then the Examiner's "a" = 2-(2 x 0.4) = 1.2; "b" = x = 0.4; "c" = b = 1; and "x" = y = 2 to 4. See for example Applicant's claim 18 where the nominal formula recited calculates to $Y_{1.2}Ba_{0.8}Cu_1O_y$. See also claim 24.

urgency. If carried out, however, it will leave Applicant at a loss as to the Examiner's position on the patentability of claims 17-26 of this Application. Surely, the Examiner is not trying to to avoid acting on the patentable merits of all claims pending in this Application.

The presently pending claims should be acted on promptly, see M.P.E.P. § 708.02. Moreover, as a general principle, M.P.E.P. § 708 requires that cases with the oldest effective filing dates be acted on first. It is believed clear that this FWC Application has an earlier filing date than any other Y-Ba-Cu-O superconductive composition application in the Patent Office. Genus claims analogous to claim 23 have been pending in this or its parent application since at least October 18, 1988. Such claims are claim 15 of Serial No. 12,205 pending since October 18, 1988 and claim 19 of this Application pending since January 23, 1989. Claims 22, 23, 25 and 26 are also allowable in Applicant's judgment. Subgenus claims have been pending in this or its parent application since at least October 18, 1988. Such claims are claim 16 of Serial No. 12,205 pending since October 18, 1988 and claim 17 of this Application pending since January 23, 1989.

A claim specific to the $Y_{1.2}Ba_{0.8}Cu_1O_y$ species has been pending in this Application since January 23, 1989 and since March 1989 in another party's application wherein the Examiner determined the species was patentable. During March 1989, there was a telephone conversation with the Examiner wherein he advised that an

interference would be declared by about the end of that examining quarter. While the Examiner did not advise of the nature or substance of the count at that time, Applicant's counsel has subsequently learned that an office action advised the third party that the claim was allowable in the March time frame.

If in March 1989 the Examiner considered a claim like claim 18 to be allowable, why the Examiner did not then act on the merits of then pending claims 17-21 in this application is a mystery. If the Examiner considers claim 18 to be the only allowable claim, an Office Action could have long ago issued holding claim 18 allowable and stating the basis for rejecting claims 17, 19, 20 or 21. Applicant could have addressed the merits of rejection and overcome the rejection or filed an appeal long before now.

For the reasons expressed at length in the Remarks of the December 1 Preliminary Amendment (second), Applicant submits that genus claims 19, 22 and 23 are patentable over all known prior art. Applicant is entitled to an action on the merits of these claims. If the Examiner declares an interference on a narrow species count relative to species claims 18, 24 and/or here submitted claim 27 without examining these claims, it will unfairly suspend ex parte prosecution. If this happens, Applicant will have to move under 37 C.F.R. § 1.615(b) for an order from the Examiner-in-Chief to continue ex parte prosecution of claims 17, 19-21, 22-23, 25-26. This can be avoided if the Examiner will act first and declare later.

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Since Applicant is presenting a claim exactly as suggested by the Examiner, pursuant to 37 C.F.R. § 1.605(a) the Examiner's attention is called to pending claims 19, 22 and 23, all of which are believed to be a more appropriate models for a count for any interference to be declared.

Claim 27, which is an exact copy of the count proposed by the Examiner, is but a species of the compositions defined by claims 19, 22 and 23. In the record so far to date, Applicant is not aware of any showing made which would provide a basis for belief that a species as defined by claim 27 is separately patentable from the genus of compositions defined by claims 19, 22 and 23. Accordingly, any of claims 19, 22 and 23 are more appropriate as a count for interference than is claim 27.

Respectfully submitted

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